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Elliott D. Light

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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

MAIL DATE

DELIVERY MODE

10/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/559,778	Applicant(s) LIGHT ET AL.	
	Examiner JAMES ZURITA	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80-86,89-98,101-110 and 113-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 80-86,89-98,101-110 and 113-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 09/04/2008 has been entered.

Response to Amendment

On 09/04/2008, applicant amended claims 80, 92, 104 and 116.

Claims 1-79, 87-88, 99-100 and 111-112 have been cancelled during prosecution.

Claims 80-86, 89-98, 101-110 and 113-116 are pending and will be examined.

Response to Arguments

Applicant's arguments filed 09/04/2008 have been fully considered but they are not persuasive.

Applicant acknowledges Applicant's comments concerning buy decision and a definition. The claims are interpreted in view of applicant's comments.

Applicant argues, part

... Because of this distinction, the communication path of the present invention enables the buy decision (discussed below) that Paltenghe completely lacks.

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In response, the Examiner notes that consumer has the opportunity to request a purchase. Paragraph 0061.

Applicant argues,

Second, Paltenghe wholly fails to disclose the buy decision claimed in the present application. The buy decision of the present application (i.e., an option for the data subject to buy the item, change his or her information and buy the item, or cancel the transaction) is different from the merchant's offer to sell described in Paltenghe at paragraphs 0026 and 0061. Whereas the offer is generated by the data recipient and forwarded from the data subject NCD to the data repository, the buy decision is generated by the data repository and sent to the data subject NCD. This distinction is important because the buy decision provides the data subject with options such as buying the item, changing the data subject's information, or cancelling the transaction. In contrast to a simple offer, which may be accepted or rejected, the buy decision incorporates the data subject's information, which the data subject may modify. Moreover, the buy decision underscores the importance of sending the offer and message from the data subject NCD to the data repository computer, since the data repository computer may then seamlessly present the buy decision back to the data subject after the requisite verifications and data- gathering. Thus, Paltenghe completely lacks a buy decision or any suggestion or motivation therefor.

Respectfully, consumers can elect to purchase, as in paragraph 0061. This was also noted in the previous rejection in as found in paragraphs 0014 and 0071, concerning purchasing information such as credit card.

The Examiner respectfully submits that he cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within individual claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 80, 92, 104 and 116 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims were amended to accommodate the option ...in response to an election to purchase the item... The claims are rendered indefinite since it is not possible to determine the scope of the claim as requiring

one item (YES or NO)

two items (YES/NO in item 248)

three items (a) a subject can elect to buy the item, (b) change the data subject's information and buy and item or (b) cancel the operation.

For purposes of this examination, examiner will give the term its broadest reasonable interpretation and consider that the particular condition is satisfied if one of the limitations is met. Prior art is interpreted to meet the claimed limitations where prior discloses that a customer requests a purchase.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 80, 81, 92, 93, 95, 104, 105, as interpreted, are rejected under 35

U.S.C. 102(e) as being anticipated Paltenghe (US PG-PUB 2001/0011250A1).

For purposes of Examination, Data subject is interpreted as a consumer/customer, data recipient is interpreted as a merchant. Data subject registration is interpreted as having a consumer's information retained on a data repository. Purchase query is interpreted as an offer to buy sent by a merchant to a consumer. Purchase reply is a consumer's acceptance of a merchant's offer.

As per claim 80, Paltenghe discloses method(s) for allowing

- a data subject (consumer, reference 25)
- to purchase (see, for example, at least paragraph 0061 and references to consumer purchases)
- an item (see, for example, at least references to goods, paragraph 0029)
- from a data recipient [merchant] (merchants and service providers, reference 27)
- over a computer network (Internet, for example, paragraph 6, network, paragraph 0045), comprising:

(a) **receiving**, from a data subject network communication device (see at least paragraph 0010)

- an offer associated with a the data recipient [merchant] (see, for example, merchant offers, paragraph 0062; they are associated with merchants) and
- a message (see, for example, message(s), as in paragraph 0049, communication messages to/from consumers and Information Bank 23) including a network

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communication device software identifier (see, for example, at least paragraph 0007 and references to cookies),

- offer and the message being received at a data repository computer (see, for example, specific merchant offers received at Information Bank, forwarded to specific consumers, the offer associated with a specific merchant being accepted by the specific consumer; then the acceptance of that offer sent to the Information Bank as message 29 from consumer 25 to Information Bank 23, as in Fig. 1);
- the offer originating from the data subject [consumer] accessing a web page of the recipient (see, for example, a customer browsing merchant sites, as in paragraph 0068; see also paragraph 0007, which discusses browsing web sites).

(b) **determining** whether the data subject is registered (see, for example, references to service account, where consumer information may be stored for future use, as in applicant's disclosures, page 26, lines 26-27);

(c) **determining** whether the data recipient [merchant] is authorized (see, for example, at least references to authorized merchants, as in paragraph 0010);

(d) [if the data subject is registered and the data recipient [merchant] is authorized], **retrieving** purchasing information associated with the data subject from a database in the data repository computer (see, for example, at least paragraphs 0014 and 0071, concerning purchasing information such as credit card);

(e) sending a buy decision to the data subject network communication device (see, for example, at least paragraphs 0026, consumers can search shop and negotiate, and 0061, the information bank sends merchant's offer to a consumer) ; and

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(f) in response to a purchase reply received from the data subject network communication device, sending purchase transaction information to the data recipient [merchant]. See, for example, at least paragraph 0029, concerning billing consumers for purchases. See also paragraph 0061, which discloses that customers request to purchase.

As per claim 81, Paltenghe discloses that determining whether the data subject [consumer] is registered includes determining whether the network communication device software identifier matches an entry in the database (see, for example, at least references to cookies, as in paragraph 0007).

Claim 92 is rejected on the same grounds as claim 80.

Claim 93 is rejected on the same grounds as claim 81.

Claim 104 is rejected on the same grounds as claim 80.

Claim 105 is rejected on the same grounds as claim 81.

Claim 116 is rejected on the same grounds as claim 80.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 82-86, 89-91, 94, 96-98, 101-103, 106-110, 113-115, as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltenghe in view of Meyers (US 6,915,271).

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As per claim 82 Palthenge **does not** specifically disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number. Meyer discloses that the offer includes a data recipient [merchant] identifier (see, for example, references to URL, as in Col. 39, lines 29-55), an item price (see, for example, at least Col. 41, line 66-Col. 42, line 25), a data recipient [merchant] digital signature (see at least Col. 47, line 48-Col. 48, line 4), a final price indicator and a transaction number (see, for example, at least Col. 41, line 66-Col. 42, line 25, total price, transaction ID number).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose that an offer includes a data recipient [merchant] identifier, an item price, a data recipient [merchant] digital signature, a final price indicator and a transaction number for the obvious reason that the details may be used for tracking and analysis on a regular basis, possibly identifying suspicious patterns.

As per claim 83, Paltenghe discloses that purchasing information associated with the data subject [consumer] includes credit card information and shipping information, the shipping information including a shipping address and a preferred shipping method (see, for example, at least paragraphs 0071, 0072).

As per claim 84, Palthenge **does not** specifically disclose determining whether the credit card information is accepted by the data recipient [merchant]. Meyer discloses determining whether the credit card information is accepted by data recipient [merchant] (see, for example, at least Col. 41, lines 22-40, Col. 50, lines 38-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyers to disclose determining whether the credit card information is accepted by the data recipient [merchant] for the obvious reason that a merchant may wish to get paid for purchases.

As per claim 85, Paltenghe discloses obtaining a new price from the data recipient [merchant] based on the shipping address and the preferred shipping method; and setting the item price equal to the new price (see, for example, at least paragraph 0072).

As per claim 86, Palthenge **does not** specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database. Meyer discloses prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database (see, for example, at least Col. 33, lines 23-34, Col. 39, lines 29-35).

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It would have been obvious to one of ordinary skill at the time the invention was made to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database.

One of ordinary skill at the time the invention was made would have been motivated to combine Palthenge and Meyer to specifically disclose prompting the data subject [consumer] for a passphrase; and authenticating the data subject [consumer] based on a passphrase stored within the database for the obvious reason that consumer information may thus be protected from unauthorized use.

As per claim 89, Palthenge **does not** specifically disclose storing the transaction information in an authorized data recipient [merchant] transaction log. Meyer discloses storing the transaction information in an authorized data recipient [merchant] transaction log (see, for example, at least Col. 50, lines 53-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in an authorized data recipient [merchant] transaction log for the obvious reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

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As per claim 90, Palthenge does not specifically disclose storing the transaction information in a data subject [consumer] transaction log. Meyer discloses storing the transaction information in a data subject [consumer] transaction log (see, for example, at least Col. 4, lines 8-31, Col. 8, lines 11-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose storing the transaction information in a data subject [consumer] transaction log for the obvious reason that merchants may wish to analyze the data periodically and on a regular basis, such as for suspicious patterns.

As per claim 91, Palthenge **does not** specifically disclose sending a transaction confirmation message to the data subject [consumer]. Meyer discloses sending a transaction confirmation message to the data subject [consumer] (see, for example, at least Col. 41, lines 22-40, Col. 42, line 59-Col. 43, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Palthenge and Meyer to disclose sending a transaction confirmation message to the data subject [consumer].

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Palthenge and Meyer to disclose sending a transaction

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confirmation message to the data subject [consumer] for the obvious reason of letting a consumer make purchases and to assure that settlement can take place.

Claim 94 is rejected on the same grounds as claim 82.

Claim 95 is rejected on the same grounds as claim 83.

Claim 96 is rejected on the same grounds as claim 84.

Claim 97 is rejected on the same grounds as claim 85.

Claim 98 is rejected on the same grounds as claim 86.

Claim 101 is rejected on the same grounds as claim 89.

Claim 102 is rejected on the same grounds as claim 90.

Claim 103 is rejected on the same grounds as claim 91.

Claim 106 is rejected on the same grounds as claim 82.

Claim 107 is rejected on the same grounds as claim 83.

Claim 108 is rejected on the same grounds as claim 84.

Claim 109 is rejected on the same grounds as claim 85.

Claim 110 is rejected on the same grounds as claim 86.

Claim 113 is rejected on the same grounds as claim 89.

Claim 114 is rejected on the same grounds as claim 90.

Claim 115 is rejected on the same grounds as claim 91.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
Primary Examiner
Art Unit 3625
24 September 2008